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IN THE  
**Supreme Court of the United States**

October Term, 1941  
No. 1024

TAMPAX INCORPORATED  
AND TAMPAX SALES CORPORATION,

*Petitioners,*

*vs.*

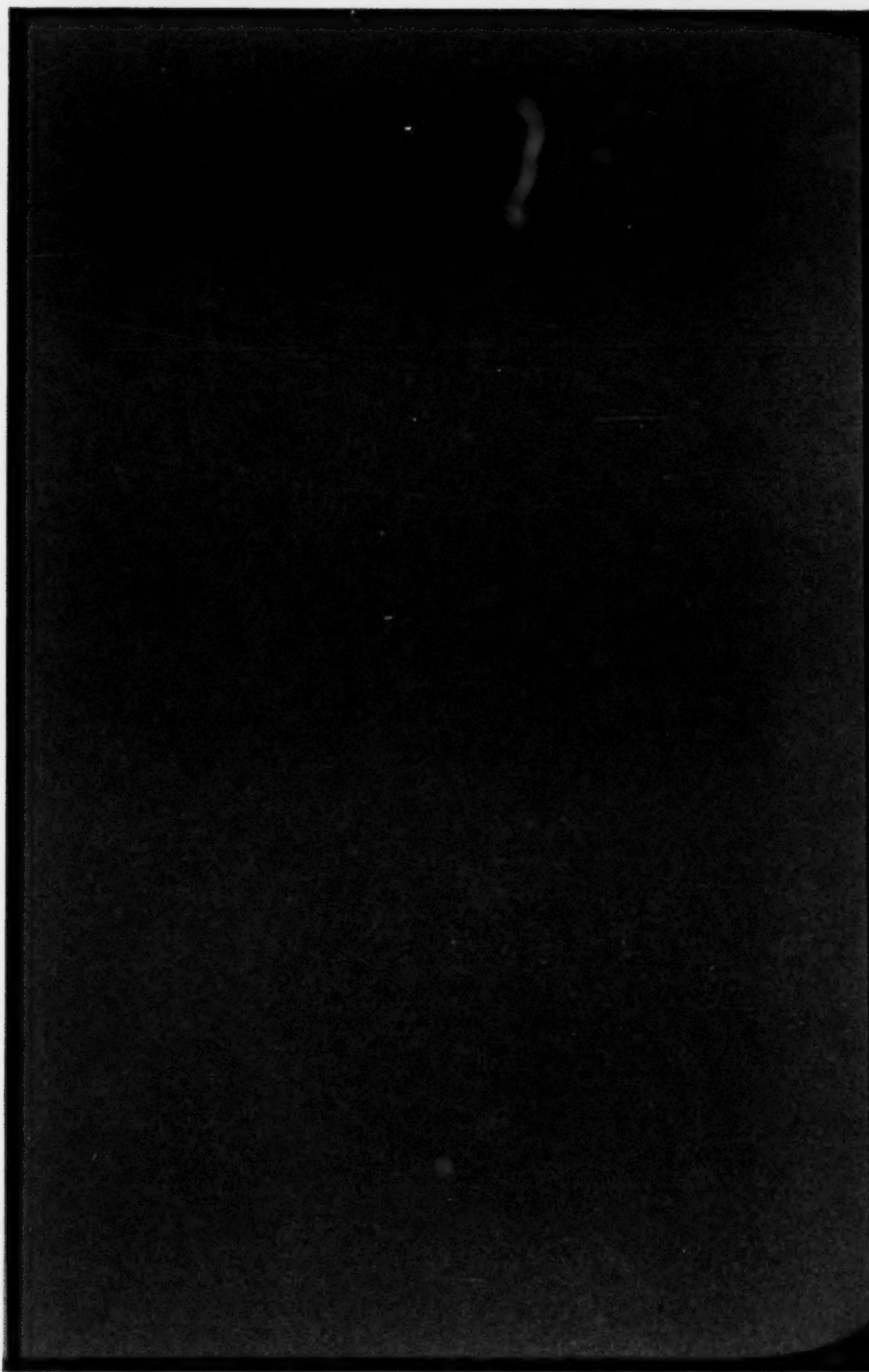
THE PERSONAL PRODUCTS CORPORATION AND  
ISIDORE H. SCHWARTZ, TRADING AS  
HIGHLAND PHARMACY,

*Respondents.*

**RESPONDENTS' BRIEF IN OPPOSITION TO  
PETITION FOR WRIT OF CERTIORARI**

STEPHEN H. PHILBIN,  
KENNETH PERRY,  
ALBERT J. FITZPATRICK,  
WILLIAM J. BARNES,

*Attorneys for Respondents.*



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Respondents.

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### RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

This is an ordinary suit for alleged patent infringement, in which the district court (R. 498), 38 F. Supp. 663, and the Second Circuit Court of Appeals (R. 505), 123 F. 2d 722, each held that petitioners' patent was not infringed, the latter court denying a petition for rehearing on December 10, 1941 (R. 518).

Because this is the only suit in which petitioners' patent has been adjudicated, there is no conflict of decisions regarding it.

Nor is there any special or important reason for granting this petition, as is required by Rule 38, subdivision 5, of this Court.

The only question in the present suit was whether a specific limitation in a patent claim, added to obtain the claim, should be disregarded, or whether, as decided by this Court in *I. T. S. Co. v. Essex Co.*, 272 U. S. 429, 444 (cited *infra*, p. 5), and by the courts below, it should be considered in deciding what the claim covered.

The petition for the writ erroneously states (p. 3):

“The question presented by this case is the following:

“Does the amplification of the specification and drawing, whether by amendment or by a ‘continuing’ application, to show in greater detail the preferred embodiment of the invention, restrict the scope of the claims to the added details?”

But that is not the question. The controlling issue was whether a patent claim to a “convoluted strip” should be construed as though the “convoluted” limitation were absent, especially when that limitation was deliberately inserted after unsuccessful attempts to obtain a broader claim.

And the “Reasons for Granting the Writ” submitted by the petition (p. 3), based as they are upon the same error as the “Question Presented”, are equally impertinent.

The theory of petitioners is fairly stated in their Specification of Errors (p. 5), where they say that the Circuit Court of Appeals erred—

“1. In holding that the scope of claim 1 is limited by ‘file wrapper estoppel’ to the precise construction illustrated and described in the drawings and specification.”

and again in their brief (p. 6) they say:

“In the case at bar the Court of Appeals in its opinion expressly holds that the claim in suit cannot be given a construction commensurate with its terms but must be construed as limited to the precise embodiment of the invention illustrated in the drawings.”

By these and other statements of similar nature, petitioners argue that the effect of the Circuit Court of Appeals decision is to establish the rule that a patent “can be infringed only by an exact Chinese copy of the par-

ticular device selected for illustration" (brief, p. 10). But the plain fact is that the court made no such holding, as a reading of its short per curiam opinion (R. 505) will show. Like the district court, it simply found that there was no infringement, because the respondents' product was not "convoluted", as called for in the single claim in suit.\*

The pertinent facts on the issue of infringement are simple.

Haas, petitioners' patentee, filed a patent application for a catamenial pad, comprising a strip of cotton with a string sewed along the length thereof. This strip was simply pushed into a die and compressed to such a degree that it retained its compressed form upon removal from the die. Such creases as were present in the finished strip were merely the haphazard, unpredictable creases resulting from the compression.

While this application was pending, Haas attempted to secure claims which called for a "convoluted" strip, which was something more than such a normally creased strip. But the Patent Office rejected these claims and Haas cancelled them, allowing his patent to issue without any such claims.

In a second, later filed application, which matured into the patent in suit, Haas illustrated (R. 180, Fig. 2) and stated that the cotton strip was arranged in definite, pre-formed "convolutions" prior to its insertion in the die, saying (R. 181, line 90):

"The next step in the manufacture of the device is to fold the pad 11 into convolutions such as shown in Fig. 2 to reduce the length thereof. This folded con-

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\* This claim reads as follows:

"1. A catamenial device comprising: a highly compressed, self-sustaining, absorbent core; and a flexible member secured to and depending from said core to form a withdrawing member, said core comprising a compressed, convoluted strip of absorbent material, said core being considerably shorter than said strip."

voluted pad is then placed into a die and pressed under high pressure on both sides and the end to form a hard cylindrical core 13 with the withdrawing member 12 extending therefrom."

In this application, he succeeded in getting claim 1 in suit, which calls for a "convoluted" strip.

The manufacturer of respondents' article starts with an ordinary cotton strip, ties a string around its middle, folds the strip in two over the string, inserts it in a die, allowing the creases to come where they will, and finally compresses the cotton until it becomes a self-sustaining wad.

The patent to Pond (R. 433) which is prior art to Haas, discloses respondents' tying and folding process. In this connection the district court said (R. 473):

"The defendant in the manufacture of its tampon, of which complaint is made in this case at bar, essentially follows the disclosure of that patent [Pond] in contrast to the first patent in suit."

The idea of forming compressed wads of cotton, or tampons, to absorb body fluids was also old, as shown in a trade publication which issued prior to 1898 (R. 467), and the use of a die to compress cotton into small wads of any desired form was, of course, old prior to Haas (Johnson patent, R. 429; Casevitz patent, R. 438).

With these facts in the record, neither of the lower courts had any difficulty in finding non-infringement. Thus the district court said (R. 476):

"The prior art does show that haphazard creases naturally and necessarily result from longitudinal compression, and I saw the demonstration on behalf of the defendant in Court, and that is exactly what took place in the making of defendant's device. I entirely disagree with plaintiff's contention that there is any convolution in defendant's device as is described in the first patent in suit."

and (R. 479):

“The defendant’s device does not have the pre-compression step of Fig. 2, of the first patent in suit, and does not infringe.”

And the Circuit Court of Appeals, after reviewing the prosecutions of the two Haas patents, referred to above, said (R. 507):

“If Haas wished to insist upon all kinds of ‘convolutions’ which might result from high pressure, he was not free to abandon haphazard ‘convolutions’ and then assert that the claim covered them.”

The same principle was declared in *I. T. S. Co. v. Essex Co.*, 272 U. S. 429, 444:

“By the limitation of the claims in the Patent Office proceeding to the three-point-contact lift the patentee made this precise form a material element, and having thus narrowed the claims, cannot, as was said in the *Weber Electric Company* case, now enlarge their scope by a resort to the doctrine of equivalents. This would render nugatory the specific limitation.”

### Conclusion.

The courts below were correct in deciding that there was no infringement. No reason appears for the grant of a writ of certiorari.

The petition should be denied.

Respectfully submitted,

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